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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,742	02/02/2005	Gerardus De Keyzer	EL/2-22733/A/PCT	2467

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EXAMINER

KUGEL, TIMOTHY J

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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08/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,742	Applicant(s) KEYZER ET AL.	
	Examiner Timothy J. Kugel	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 5,8,11 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,9,10 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/02/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-16 are pending as amended on 2 February 2005. Claims 5, 8, 11 and 16 are withdrawn from consideration.

Election/Restrictions

2. Applicant's election of the invention of Group I, claims 2-4, 6, 7, 9, 10, 12-15 and linking claim 1, in the reply filed on 10 June 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)) and is therefore made **FINAL**.

Information Disclosure Statement

3. The information disclosure statement filed 2 February 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but unless the references have been cited by the examiner on form PTO-892, the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 USC 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-4, 6, 7, 9, 10 and 12-15 are rejected under 35 USC § 103(a) as being unpatentable over US Patent Application Publication 2002/0045111 (Machiguchi hereinafter) in view of Hu, Mougang et al., "Hydroxyphthalocyanines as Potential Photodynamic Agents for Cancer Therapy", Journal of Medicinal Chemistry (1998), 41(11), 1789-1802 (Hu hereinafter) or applicant's admission. Machiguchi is the US equivalent to European Patent Publication EP 1168048, which was cited as a Y-reference on the International Search Report for PCT/EP03/08654. Hu was cited as an X-reference on the same search report.

Machiguchi teaches a color filter having equal areas of three colors (Figure 2), wherein the green filter area has a large transmittance at a wavelength of 535 nm (¶¶0010 and 0019) wherein the green filter comprises a phthalocyanine compound similar to that of Formula (I) instantly claimed except having sulfur-containing substituents (¶¶0047-0064) and further comprising a yellow dye (¶0077) wherein the dyes are dispersed within an alkali-soluble resin—which reads on the high molecular

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weight material instantly claimed—in ratios of from 3 to 55 parts per weight resin per 100 parts dye (¶0101).

Machiguchi does not disclose expressly a phthalocyanine compound having the same substituents—for example -OH substituents as instantly claimed.

Mougang discloses a phthalocyanine dye having absorption in the 650-800 nm range (Page 1789 ¶3) having one, two or three hydroxy substituents as instantly claimed (Schemes 3 and 4, Page 1792).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the hydroxy-substituted phthalocyanine dye of Mougang in the filter of Machiguchi. The rationale to do so would have been the motivation provided by the teaching of Mougang that such dye would have an absorption in the 650-880 nm range and further since it has been held that it is *prima facie* obviousness to use a known material based on its suitability for its intended use (*Sinclair & Carroll Co. v. Interchemical Corp.*, 325 US 327, 65 USPQ 297 (1945), *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) and *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988)).

Still further, applicant admits that “The instant compounds of formula (I) are partially known, partially new. Those which are new can be made easily in analogy to known methods” (Instant Specification Page 4 Lines 8-9). Therefore it would obvious to one of ordinary skill in the art at the time the invention was made to include the compounds of Formula (I) in the filter of Machiguchi.

Conclusion

5. Regarding the X-references cited on the International Search Report for PCT/EP03/08654 that were not relied-upon:

Both Rager, Christine et al.: Influence of Substituents, "Reaction Conditions and Central Metals on the Isomer Distributions of 1(4)-tetrasubstituted phthalocyanines", Chemistry—A European Journal (1999), 5(1), 280-288 (Rager hereinafter) and Ruf, Michael et al.: "Silicon and Zinc Coordination to Peripheral Catechol Sites of (2,3,9,10,17,17,23,24-Octahydroxyphthalocyaninato)nickel(II). Phthalocyanine Coordination Chemistry at the Edge", Inorganic Chemistry (1998), 37(8), 1992-1999 (Ruf hereinafter) teach similar phthalocyanine dyes to that instantly claimed, but with different substituent groups than instantly claimed.

Guo, L. et al.: "Ligand Substitution Effect on Optical Properties in Conducting Tetraazaporphyrines", Materials Research Society Symposium Proceedings, Materials Research Society, Pittsburg, PA, US, vol. 393, 1995, pages 137-142 (Guo hereinafter) was not available, but a copy of the article has been ordered and it will be treated in a subsequent action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached on 6:00 AM - 4:30 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy J. Kugel/
Patent Examiner, AU 1796